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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,442	11/26/2003	Ernie Lin	12203-007001	5974
26161	7590	03/23/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			TRAN, TUAN A	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,442

Applicant(s)

LIN ET AL.

Examiner

Tuan A Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/23/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 11-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10-12, 14, 19-22 and 32 of copending Application No. 09/658,049. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 11-15 of the instant application recites the subject matters of claims 1, 10-12, 14, 19-22 and 32 of the copending Application No. 09/658,049 in broader version and with various wordings .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-2, 7-8 and 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Liebenow (6,522,640).

Regarding claims 1-2, 7-8 and 10, Liebenow discloses a modem comprising: a base unit (See fig. 4) for transmitting a data signal, wherein the base unit is in communication with a telephone line and receives an original signal from the telephone line, the base unit generating an RF modulated signal based on the original signal (See figs. 2, 4 and col. 5 lines 1-52, col. 7 lines 12-24); and a communication card (See fig. 3) which receives the data signal from the base unit over a wireless medium and performs echo canceling on the data signal, wherein: the communication card is in communication with the base unit and a computer, the communication card receiving an

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original signal from the computer, generating an RF modulated signal based on the original signal from the computer and transmitting the RF modulated signal to the base unit (See figs. 2-3 and col. 3 lines 62-65, col. 4 lines 33-67, col. 5 lines 46-52); the communication card includes an RF transceiver, the communication card communicating with the base unit by wireless communication via the RF transceiver (wireless mode) and with the computer via wired link (wire-line mode). The communication card inherently includes a switch for automatically selecting the mode for transmitting/receiving the data signals in response to presence or absence of a wired and/or wireless connections (See figs. 2-3 and col. 4 lines 33-67, col. 5 lines 22-52, col. 6 lines 37-54).

Claims 11-15 are rejected for the same reasons as set forth in claims 1-2, 7-8 and 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liebenow (6,522,640).

Regarding claim 6, Liebenow discloses as cited in claim 1. However, Liebenow does not mention that the data signal is transmitted using FSK modulation. Since FSK

modulation is well known in the art; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use FSK modulation for modulating the data signals for the advantage of expanding the capability of the system to various modulation schemes.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebenow (6,522,640) in view of Brandt (4,727,535).

Regarding claims 3-5, Liebenow discloses as cited in claim 2. Liebenow further discloses the base unit comprises a transmitter (See fig. 2). However, Liebenow does not mention that the base unit comprises a circuitry which generates a composite data signal from the original signal from the telephone line and echo signals and which maintains a peak voltage excursion of the composite data signal within a linear amplification region of the transmitter, wherein the circuitry comprises an AGC circuit and wherein the AGC circuit uses a DC current of a telephone loop to set a gain level for the original signal at a beginning of communication, the gain level remaining substantially constant during communication. Brandt teaches a coupling device (See fig. 1) comprising a circuitry which generates a composite data signal from the original signal from the telephone line and echo signals and which maintains a peak voltage excursion of the composite data signal within a linear amplification region of the transmitter, wherein the circuitry comprises an AGC circuit and wherein the AGC circuit uses a DC current of a telephone loop to set a gain level for the original signal at a beginning of communication, the gain level remaining substantially constant during communication (See figs. 1-2 and col. 3 line 6 to col. 6 line 15). Since both the

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Liebenow's base unit and the Brandt's coupling device act as a telephone network interface; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the base unit with the circuitry as disclosed by Brandt for the advantage of maintaining circuit isolation and automatic gain control.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liebenow (6,522,640) in view of Henderson (6,611,681).

Regarding claim 9, Liebenow discloses as cited in claim 7. However, Liebenow does not mention that the communication card includes a ringer emulator, wherein a low frequency signal generator is used to emulate ringer detection circuit when a ringing signal is detected in the base unit and transmitted over the wireless medium to the communication card, the ringer emulator emulating ringer detection in a telephone interface and feeding a signal to a modem circuit to receive of incoming call.

Henderson teaches a cordless telephone system wherein the cordless handset includes a ringer emulator, wherein a low frequency signal generator is used to emulate ringer detection circuit when a ringing signal is detected in the base unit and transmitted over the wireless medium to the cordless handset, the ringer emulator emulating ringer detection in a telephone interface and feeding a signal to the handset circuit to receive of incoming call (See fig. 2 and Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the Henderson's teaching in modifying the Liebenow's system for the advantage of notifying users about the incoming call in order to establish the communication.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(703) 605-4255**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached at **(703) 308-6739**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

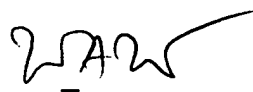
Washington, D.C. 20231

or faxed to:


(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


Tuan Tran

AU 2682


VIVIAN CHIN
SUPERVISOR, PATENT EXAMINER
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3/21/05

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